

REMARKS

Summary of the Office Action

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 4,623,082 to Kurosawa hereinafter ("Kurosawa").

Claims 3, 4, 6, 7, 9, 10, and 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurosawa.

Claims 2, 5, 8 and 11 stand objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Summary of the Response to the Office Action

Claims 1 and 4 have been amended. Claims 15-18 have been added. Accordingly, claims 1-18 are presently pending

Allowable Subject Matter

Applicant wishes to thank the Examiner for indicating allowable subject matter in claims 2, 5, 8 and 11.

The Rejections Under 35 U.S.C. §§ 102 and 103

Claim 1 stands rejected under 35 U.S.C. § 102(b) as being anticipated by Kurosawa. Claims 3, 4, 6, 7, 9, 10, and 12-14 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Kurosawa. Applicant respectfully traverses these rejections for at least the following reasons.

In Applicant's Amendment filed on May 3, 2006, Applicant argued, in part, that Kurosawa does not teach or suggest at least "detecting the '**remaining amount** of sheet-like staples..." (emphasis in original). However, it does not appear that the final Office Action addressed this argument. Thus, Applicant respectfully maintains that Kurosawa does not teach or suggest at least "a **remaining amount** of the sheet-like staples is detected based on the detection of the position of the engaging plate by the position detecting mechanism," (emphasis added) as required by amended claim 1.

Kurosawa discloses a photosensor which detects "whether the staple sheet 25 is present or absent in the cartridge 2..." (Col. 9, lines 51-54). In Kurosawa, the position detection means (photosensor PT2) detects whether the sheet-staples (25) are present or absent, it does not detect the position of the engaging plate (26). That is, Kurosawa only discloses detecting whether there are staples or there are no more staples left. (Col. 10, lines 9-11). In contrast, the present invention according to amended claim 1 is able to detect the "**remaining amount** of sheet-like staples," (emphasis added) not merely just whether there are any staples left.

As pointed out in MPEP § 2131, “[to] anticipate a claim, the reference must teach every element of the claim.” Thus, “[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.

Verdegaal Bros. v. Union Oil of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987).”

Accordingly, Applicant respectfully requests that the rejection of claim 1 under 35 U.S.C. § 102(b) be withdrawn.

As pointed out in MPEP § 2143.03, “[to] establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” Applicant respectfully submits that claim 4 is in condition for allowance for reasons similar to those stated above with respect to independent claim 1. Accordingly, Applicant respectfully requests that the rejection of independent claim 4 under 35 U.S.C. § 103(a) be withdrawn. Furthermore, Applicant respectfully submits that dependent claims 3, 6, 7, 9, 10, and 12-14 are allowable at least because of their dependence on independent claims 1 and 4 respectively and the reasons set forth above.

Furthermore, as to claims 13 and 14, the Office Action states, “the reference staple apparatus of Kurosawa does expressly state about at least three position [sic] of the engaging plate, however, the detecting mechanism is capable of such function as detecting at least three position of the engaging plate (26).” Applicant respectfully submits that nowhere in Kurosawa does it teach that “the position detecting mechanism detects at least three positions of the engaging plate...,” as recited in claims 13 and 14. Applicant respectfully notes that the Office

Action does not cite to any portion of Kurosawa that teaches the aforementioned claimed limitation.

In addition, Applicant renews Applicant's objection to the "Official Notice" taken in the Office Action as to claims 3 and 6 and traverses this "Official Notice" taken in the Office Action as to claims 9 and 12 and requests that documentary evidence be provided. As pointed out in MPEP § 2144.03(A), "[i]t is never appropriate to rely solely on 'common knowledge' in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based." (*citing In re Zurko*, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001)).

"While 'official notice' may be relied on, these circumstances should be **rare** when an application is under **final** rejection..." (emphasis added). Also, MPEP § 2144.03(C), states that "[i]f applicant adequately traverses the examiner's assertion of official notice, the examiner **must** provide documentary evidence in the next Office action if the rejection is to be maintained." (emphasis added) (*citing* 37 C.F.R. § 1.104(c)(2) and Zurko, 258 F.2d at 1386, 59 USPQ2d at 1697).

As to claims 3, 6, 9, and 12, Applicant respectfully submits that the applied art does not teach or disclose detecting the **remaining amount** of sheet-like staples by determining the **position** of the engaging plate based on the **number of times** of transmitting and cutting off light irradiated to the portion of transmitting and portion of reflecting light, respectively, as claimed. Pages 3 to 6 of the Office Action dated July, 19, 2006, like the pages 4 and 5 of the Office Action dated February 10, 2006, again, admit that Kurosawa does not disclose "cutting off light

irradiated to the portion of transmitting and the portion of reflecting light, and the remaining amount of the [sheet-like staple is/roll-like staples] detected based on the detection of the position of the engaging plate.” Nonetheless, the Office Action asserts “Examiner Takes Official Notice that photosensor irradiating light and cutting off is well known in the art and would have been obvious to one skilled in the art to provide for accurate detection of the staples.” Even if what the Examiner takes Official Notice of were true, it still does not teach that “the position of the engaging plate is detected by the number of times of transmitting and cutting off light...,” as recited in claims 3, 6, 9 and 12.

Additionally, Applicant notes that the Office Action has provided no teaching or suggestion in the prior art that it would have been obvious to one of ordinary skill in the art to modify Kurosawa as mentioned above. Applicant submits that the features of claims 3, 6, 9, and 12 are not obvious to one of ordinary skill in the art. The MPEP instructs that “[t]he mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination.” The MPEP further instructs that “[a]lthough a prior art device ‘may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.’” MPEP § 2143.01. Applicant respectfully submits that the rejections of claims 3, 6, 9, and 12 is improper in view of MPEP §§ 2143.01 & 2144.03 because it lacks evidence of a teaching or suggestion that the features would have been obvious to one of ordinary skill.

CONCLUSION

In view of the foregoing, Applicant respectfully requests reconsideration and the timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of the response, the Examiner is invited to contact the Applicant's undersigned representative to expedite prosecution.

If there are any other fees due in connection with the filing of this response, please charge the fees to our Deposit Account No. 50-0310. If a fee is required for an extension of time under 37 C.F.R. 1.136 not accounted for above, such an extension is requested and the fee should also be charged to our Deposit Account.

Respectfully submitted,

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